

REMARKS

Claims 53-112 are currently pending.

In the Office Action, the Examiner requires that the claims be restricted to one of the following three species under PCT Rule 13.1:

Species A, drawn to optical fiber coating claims expressly referring to at least one ethylenically unsaturated polyurethane having a glass transition temperature (T_g) between -40°C . and -100°C .; and (b) at least one polyfunctional reactive diluent monomer (e.g., claims 68-93, 101-102, and 112).

Species B, drawn to composition claims expressly referring to at least one ethylenically unsaturated polyurethane having a glass transition temperature (T_g) between -40°C . and -100°C .; (b) at least one polyfunctional reactive diluent monomer; and not explicitly mentioning an optical fiber (e.g., claims 94-100 and 103-105).

Species C, drawn to optical fiber coating claims not expressly referring to at least one ethylenically unsaturated polyurethane having a glass transition temperature (T_g) between -40°C . and -100°C .; and (b) at least one polyfunctional reactive diluent monomer (e.g. claims 53-67 and 106-111).

See Oct. 28, 2008, Office Action at 2.

Applicants respectfully traverse this so-called species election requirement. However, to be fully responsive, Applicants elect, with traverse, "Species A." The Examiner asks for a listing of all claims "readable" on the election of species. *See id.* Applicants note that at least elected claims 53-93 and 106-112 are readable thereon.

While the Examiner has identified this as a species election, the Examiner has not in fact requested Applicants to elect a species. A species election means that an Applicant is required to elect one or more species of a generic claim limitation, irrespective of the type of claim (product, process, apparatus, etc.). Here, a cured

“radiation curable composition comprising (a) at least one ethylenically unsaturated polyurethane having a glass transition temperature (T_g) between $-40\text{ }^{\circ}\text{C}$ and $-100\text{ }^{\circ}\text{C}$ and (b) at least one polyfunctional reactive diluent monomer” is a species of the claim limitation “protective coating layer.” However, rather than having Applicants elect a species of which the above recitation is one, the Examiner has improperly demanded that “Species A” and “Species B” be limited to this single species and that “Species C” be open ended.

Moreover, by defining “Species A” as being drawn to optical fiber coating claims and “Species B” being drawn to a composition, the Examiner has made a unity of invention rejection without making any attempt to meet the burdens required by such a rejection.

By making this election, Applicants understand that the claims being prosecuted in this application have been restricted to claims reciting either an optical fiber comprising the protective coating layer or a method comprising the provision of the protective coating layer. Thus, a divisional application may be later filed directed to the composition claims. If the Examiner disagrees, Applicants request a further clarification of this rejection.

Further, it is Applicants’ understanding that by making this election, the species initially being considered is a cured “radiation curable composition comprising (a) at least one ethylenically unsaturated polyurethane having a glass transition temperature (T_g) between $-40\text{ }^{\circ}\text{C}$ and $-100\text{ }^{\circ}\text{C}$ and (b) at least one polyfunctional reactive diluent monomer.” Again, if the Examiner disagrees, Applicants request a further clarification of this rejection.

The Examiner asserts that the “species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: “Species B” only refers to a composition without reference to coating an optical fiber. “Species C” refers to an optical fiber coating but does not claim ethylenically unsaturated polyurethane and at least one polyfunctional reactive diluent monomer.” *Id.* at 3.

Applicants respectfully traverse the election of species requirement, at least because the Examiner has failed to show that a serious burden exists to examine all of the alleged species. To make a proper requirement for an election of species the Examiner must, *inter alia*, show that the search and examination of a claim would impose a serious burden on the Office because it embraces an unreasonable number of species. See M.P.E.P. § 803.02. Here, the Examiner has provided no reasons or evidence on the record to substantiate the election of species requirement, let alone how examination of all the species would impose a serious burden.

If the Examiner chooses to maintain the election of species requirement, Applicants expect the Examiner, if the elected species is found allowable, to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, *i.e.*, extending the search to a “reasonable” number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

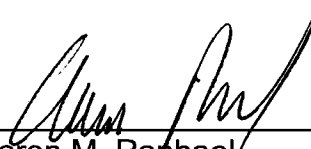
If there is any fee due in connection with the filing of this Statement, please
charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 10, 2008

By: _____


Aaron M. Raphael
Reg. No. 47,885
(202) 408-4000